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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,242	11/29/2000	Tatsuo Yoshioka	503.39354X00	8235

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EXAMINER

KOPPIKAR, VIVEK D

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 06/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/725,242

Applicant(s)

YOSHIOKA ET AL.

Examiner

Vivek D Koppikar

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*ML*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/29/2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Status of Application***

1. This communication is in response to the application filed on November 29, 2000. This non-provisional application claims priority to Japanese Application 2000-205783. As of the date of this communication the applicants have not filed an Information Disclosure Statement (IDS). Claims 1-19 are pending in the application and have been examined.

### ***Claim Rejections - 35 USC § 101***

2. Claims 1-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

3. For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

4. In the present case, claims 1-19 only recite an abstract ideas. The recited steps of merely describe a process of offering a service at a given price and for allowing the user of the service to pay for the service using a payment means similar to a debit/credit card and does not apply,

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involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to select and pay for a service.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 12-13 and 18-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term “other service” in claims 12 and 13 render these claims indefinite. It is not clear what types of services are encompassed by the term “other service”. Appropriate correction and/or clarification is required.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-4 and 6-9 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Number 6,609,658 to Sehr.

Sehr is directed towards a travel system and method utilizing multi-application traveler cards.

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As per claims 1-4, 6 and 8-9, which are directed towards a service processing system, Sehr teaches means for setting a point value (price) for consideration (fee) of a service to be offered, a point value to be received as a consideration (fee) when a service is given is informed to a service user (consumer) who desires to receive the service and when the service has been offered, the service provider receives the point value (money) from the service user (consumer) as the consideration (fee) of the service offering (Col. 6, Ln. 20-55; Col. 8, Ln. 6-24 and Col. 10, Ln. 25-65). Sehr also provides a means of displaying a plurality of service contents (successively) and corresponding point values (prices) which are presented to the service user (consumer) when receiving a selection result among the plurality of services (Col. 33, Ln. 31-50). A point calculation processing (debit) for the service user (consumer) is performed based on the given point value (price) for the service user (consumer) and the selection result (choice of consumer) of the service to be offered (Col. 4, Ln. 31-47; Col. 6, Ln. 20-42; Col. 10, Ln. 25-65 and Col. 16, Ln. 22-Col. 17, Ln. 6). Once the service has been provided to the user the service provider receives a report that the service has been completed and is performed (Col. 43, Ln. 5-49).

As per claim 7, in Sehr the communications in the travel system between the service providers and the users take place via a communication line (Col. 6, Ln. 20-42).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Number 6,609,658 to Sehr.

Claim 5 is directed towards a system for purchasing insurance in which the premium (price) for insurance varies based on the policy purchases and the periods of coverage. This insurance is also paid for by a debit card.

Sehr discloses purchasing various goods and services (e.g. travel services) via a debit card; however, per se does not disclose purchasing insurance. However Sehr discloses that the travel services database may be coupled to an insurance database (Col. 44, Ln. 49-52).

At the time of the invention, one of ordinary skill in the art would have been motivated to include a means to purchase insurance in the online travel services purchasing system of Sehr in order to provide the consumer/customer with more services and more convenience when planning a trip or vacation (travelers frequently purchase travel insurance or supplementary car insurance).

11. Claims 10-11 and 14-17 are rejected 35 U.S.C. 103(a) as being unpatentable over US Patent Number 6,609,658 in view of US Patent Number 6,098,101 to Sears.

As per claim 10, which are directed towards a processing system for providing services, Sehr teaches means for setting a point value (price) for consideration (fee) of a service to be offered, a point value to be received as a consideration (fee) when a service is given is informed to a service user (consumer) who desires to receive the service and when the service has been offered, the service provider receives the point value (money) from the service user (consumer) as the consideration (fee) of the service offering (Col. 6, Ln. 20-55; Col. 8, Ln. 6-24 and Col. 10,

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Ln. 25-65). Sehr also provides a means of displaying a plurality of service contents (successively) and corresponding point values (prices) which are presented to the service user (consumer) when receiving a selection result among the plurality of services (Col. 33, Ln. 31-50). A point calculation processing (debit) for the service user (consumer) is performed based on the given point value (price) for the service user (consumer) and the selection result (choice of consumer) of the service to be offered (Col. 4, Ln. 31-47; Col. 6, Ln. 20-42; Col. 10, Ln. 25-65 and Col. 16, Ln. 22-Col. 17, Ln. 6). Sehr also teaches a means of allowing the user to enter necessary personal data and means for recording this data (Col. 43, Ln. 5-48).

Sehr fails to teach a means of receiving a report from the service provider that the car use service has been completed and has been performed; however, this feature is well known in the art as evidenced by Sears (Col. 3, Ln. 33-35). At the time of the invention, one skilled in the art would have been motivated to modify the travel services purchasing system of Sehr by adding a usage report generator, as recited in Sears, in order to allow the administrator of the service provider to monitor and keep track of all transactions in an organized and efficient manner.

As per claim 11, Sehr discloses purchasing various goods and services (e.g. travel services) via a debit card; however, per se does not disclose purchasing insurance. However Sears discloses that the travel services database may be coupled to an insurance database (Col. 44, Ln. 49-52).

At the time of the invention, one of ordinary skill in the art would have been motivated to include a means to purchase insurance in the online travel services purchasing system of Sehr in order to provide the consumer/customer with more services and more convenience when

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planning a trip or vacation (travelers frequently purchase travel insurance or supplementary car insurance).

As per claims 14-15, in Sehr the user is able to select a car based on a list of options (Col. 33, Ln. 31-34). The examiner therefore takes Official Notice on these features and, at the time of the invention, one of ordinary skill in the art would have been motivated to include these features in order to allow the user of the travel services system to better specify and select the type of vehicle that they would have liked to rent or lease.

As per claims 16-17, in Sehr the use period of the car is a time interval in which the service user occupies and uses the car (Col. 33, Ln. 31-50).

### ***Conclusion***


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Vivek Koppikar** whose telephone number is **(703) 305-5356**. The examiner can normally be reached on Monday-Friday from 8 AM to 5 PM, Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (703) 305-9588. The fax phone number for the organization where this application or proceeding is assigned are (703) 872-9306.

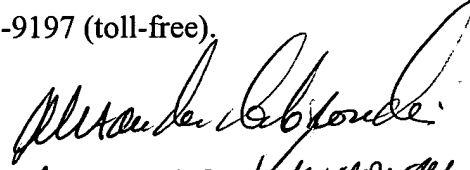


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13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Vivek Koppikar

5/26/04

  
ALEXANDER KUZNETSOV  
Art 3626  
Primary Examiner